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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,849	03/21/2001	Yusuke Hayashi	826.1704	1438

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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/06/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/812,849

Applicant(s)

HAYASHI, YUSUKE

Examiner

Joshua D Campbell

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Application filed on 03/21/2001 and priority papers filed on 03/21/2001.
2. Claims 1-15 are pending in this case. Claims 1, 2, 5, 7, 8, 11, 12, 13, 14 and 15 are independent claims.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawings were received on 03/21/2001. These drawings are accepted.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, in claim

1, "outputting to the user information showing how the information that meets the requirements is treated in an information source as layout information...", and claim 2, "outputting the retrieved how-treated-in-source information...".

In order to further prosecution the examiner has interpreted the claims to be the broadest possible meaning in spite of the idiomatic English. Proper correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US Patent Number 6,460,036 filed December 5, 1997) in view of Kent (US Patent Application Publication Number 2002/0040374 with a filing date of October 4, 2000.)

Regarding independent claim 1, Herz discloses a method in which information is presented to a user in an order based on how it fits requirements set forth by the user (column 4, line 37-column 8, line 10 of Herz). From this information a specification (template) of the information that the user would like to see is created and based on the specification the information is transmitted to the user (column 4, line 37-column 8, line 10 of Herz). Herz does not disclose a method in which information is presented to show

that it meets the requirements based on layout information. However, Kent discloses a method in which requirements can be set in that are met by how the information is actually laid out and presented based on that (Page 2, paragraph 0010 of Kent). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Kent with the method of Herz because it would have resulted in increased circulation of information due to increased ability to customize.

Regarding independent claim 2, Herz discloses a method in which information is presented to a user in an order based on how it fits requirements set forth by the user which are stored as user preferences (column 4, line 37-column 8, line 10 of Herz). From this information a specification (template) of the information that the user would like to see is created and based on the specification the information is transmitted to the user (column 4, line 37-column 8, line 10 of Herz). Herz does not disclose a method in which information is presented to show that it meets the requirements based on layout information based on how it is treated in the source. However, Kent discloses a method in which requirements can be set in that are met by how the information is actually laid out and presented based on that (Page 2, paragraph 0010 of Kent). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Kent with the method of Herz because it would have resulted in increased circulation of information due to increased ability to customize.

Regarding dependent claims 3 and 4, Herz discloses a method in which the position of the information in the resulting source provides the user with a measure of the importance degree or degree of relevance (column 58, lines 25-54 of Herz).

Regarding dependent claim 5, Herz discloses a method in which an external party presents information to a user in an order based on how it fits requirements set forth by the user that disclose the type of information a user would likely require (column 4, line 37-column 8, line 10 of Herz). From this information a specification (template) of the information that the user would like to see is created and based on the specification the information is transmitted to the user (column 4, line 37-column 8, line 10 of Herz). Herz does not disclose a method in which information is presented to show that it meets the requirements based on layout information. However, Kent discloses a method in which requirements can be set in that are met by how the information is actually laid out and presented based on that (Page 2, paragraph 0010 of Kent). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Kent with the method of Herz because it would have resulted in increased circulation of information due to increased ability to customize.

Regarding independent claim 7, the claim incorporates substantially similar subject matter as claim 1. Thus, the claim is rejected along the same rationale as claim 1.

Regarding independent claim 8, the claim incorporates substantially similar subject matter as claim 5. Thus, the claim is rejected along the same rationale as claim 5.

Regarding dependent claims 6, 9, 10, the claims incorporate substantially similar subject matter as claim 3. Thus, the claims are rejected along the same rationale as claim 3.

Regarding independent claim 11, Herz discloses a method in which information is presented to a user in an order based on how it fits requirements set forth by the user which are stored as user preferences (column 4, line 37-column 8, line 10 of Herz). From this information a specification (template) of the information that the user would like to see is created and based on the specification the information is transmitted to the user (column 4, line 37-column 8, line 10 of Herz). Herz does not disclose a method in which information is presented to show that it meets the requirements based on layout information based on how it is treated in the source. However, Kent discloses a method in which requirements can be set in that are met by how the information is actually laid out and presented based on that (Page 2, paragraph 0010 of Kent). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Kent with the method of Herz because it would have resulted in increased circulation of information due to increased ability to customize.

Regarding independent claim 12, Herz discloses a method in which an external party presents information to a user in an order based on how it fits requirements set forth by the user that disclose the type of information a user would likely require (column 4, line 37-column 8, line 10 of Herz). From this information a specification (template) of the information that the user would like to see is created and

based on the specification the information is transmitted to the user (column 4, line 37- column 8, line 10 of Herz). Herz does not disclose a method in which information is presented to show that it meets the requirements based on layout information.

However, Kent discloses a method in which requirements can be set in that are met by how the information is actually laid out and presented based on that (Page 2, paragraph 0010 of Kent). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Kent with the method of Herz because it would have resulted in increased circulation of information due to increased ability to customize.

Regarding independent claim 13, the claim incorporates substantially similar subject matter as claim 2. Thus, the claim is rejected along the same rationale as claim 2.

Regarding independent claim 14, the claim incorporates substantially similar subject matter as claim 11. Thus, the claim is rejected along the same rationale as claim 11.

Regarding independent claim 15, the claim incorporates substantially similar subject matter as claim 12. Thus, the claim is rejected along the same rationale as claim 12.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 5,649,186

US Patent Number 5,761,662

US Patent Number 6,029,182

US Patent Number 6,401,094

US Patent Number 6,571,279

US Patent Application Publication Number 2002/0054089

US Patent Application Publication Number 2002/0055959

US Patent Application Publication Number 2004/0024747

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC
April 29, 2004

A handwritten signature in black ink, appearing to read "Sanjiv Shah", with a stylized flourish at the end.

SANJIV SHAH
PRIMARY EXAMINER